

*E1
conced.* wherein a gas passes through said peripheral apertures between the inside and the outside of said drum.

REMARKS

I. Introduction

Applicants' representatives thank the examiner for the courtesies extended to the applicants' representatives during the Telephone Interview. Claims 1-22, 24 and 25 are pending in the application.

Applicants have revised claim 1 to clarify that peripheral apertures contained in the drum of the claimed device are defined by the space between mutually parallel sections and a gas passes through the peripheral apertures between the inside and the outside of the drum. Support for the amendment of claim 1 can be found throughout the specification, for example, at page 4, lines 24-33 and drawings.

Although applicants believe that this amendment simply clarifying the claimed invention would not change the scope of the claims previously presented, applicants submit this amendment with a Request for Continued Examination to ensure its entry.

II. Rejections under 35 USC § 112, first paragraph

Claims 1-22 are rejected under 35 U.S.C. § 112, first paragraph as non-enabled. In particular, while citing the limitation "said apertures that form a path for a gas flow between the inside and the outside of said drum," the Office Action asserts that conduit 36 for supplying air to the device is required to enable the claimed device. Applicants respectfully traverse this rejection.

The Office Action appears to contend that "conduit 36" is essential and thus is required to be recited in claim 1. In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567 (CCPA 1976).

In this regard, applicants would like to direct the examiner's attention to the recitation of claim 1, "a member of supplying gas," which is inclusive of "conduit 36." A member of supplying gas in the claimed device is described in the specification, for

example, page 4, lines 24-25 and claim 13. "Conduit 36" is merely a preferred embodiment to explain how gas flows between the inside and the outside of the drum through apertures formed mutually parallel sections. (See page 5, lines 23-26 and page 8, lines 11-32).

Thus, a proper reading of claim 1 in light of the specification clearly shows that one of ordinary skill in the art would be able to design an appropriate "member of supplying gas" to achieve the function recited in claim 1, without being limited to use of "conduit 36". Therefore, because the specification does not require only using "conduit 36," the instant rejection based on the grounds that "conduit 36" is missing from claim 1 cannot be sustained. Accordingly, applicants respectfully request reconsideration and withdrawal of the enablement rejection.

III. Rejections under 35 USC § 112, second paragraph

Claims 1-22 are rejected 35 U.S.C. § 112, second paragraph as indefinite. In particular, the Office Action states that it is unclear as to what "'said apertures' is referring to". Applicants respectfully traverse this rejection.

The apertures are illustrated in Figures 3 and 4 and described in a preferred embodiment on page 6, lines 25-30 and page 8, lines 11-32 of the specification. Thus, the meaning of the apertures is clear and definite from the specification. Recitation of "apertures" first appears in a preamble of claim 1 as "peripheral apertures," "said apertures" secondly appears in the "wherein" clause. Therefore, it is apparent that "said apertures" are referring to "peripheral apertures" in the preamble of claim 1. Nonetheless, applicants respectfully submit that amendment of claim 1 to recite "said peripheral apertures" in both the preamble and the body of claim 1 renders the rejection moot, and warrants withdrawal of this rejection.

III. Rejection under 35 USC § 103

In the Office Action, claims 1-17 and 19-21 stand rejected as obvious over EP 648,529 to Fusejima et al. ("Fusejima I"). In addition, the Office Action further maintains the rejection of claims 18 and 22 as obvious over Fusejima I and U.S. Patent

No. 5,939,097 to Fusejima et al. ("Fusejima II"). Applicants respectfully traverse these rejections.

According to a proper reading of amended claim 1, (1) mutually parallel sections are contained in the drum of the claimed device comprises, (2) apertures are defined by the space between the mutually parallel sections, and (3) a gas passes through the apertures between the inside and the outside of the drum.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

However, Fusejima 1 neither teaches nor suggests "a drum comprising apertures that are defined by the space between mutually parallel sections." Fusejima I, teaches a device where "circular frame members 51a and 52a are respectively provided at opposite end portions in the axial direction of the cylindrical portion 2 formed therein with a multiplicity of vent holes 16. A plurality of partition plates 52 extending in the radial direction of the drum 1 are provided at the outside of the cylindrical portion 2 and at the position between the both frame members 51a and 51b." (column 11, line 58 to column 12, line 8). Because the partition plates 52 between frame members 51a and 51b are positioned at the outside of the cylindrical portion, they cannot define apertures as recited in claim 1. Instead, Fusejima I teaches a drum with a cylindrical portion having vent holes. (See also Figure 2). However, nowhere does Fusejima I teach or suggest that the partition plates, by the space between them, can define or form apertures in the drum.

In Fusejima I, the vent holes contained in the cylindrical portion of the drum serve an entry or outlet through which a gas passes between the inside and the outside of the drum, as the apertures of the claimed device do. However, Fusejima I fails to recognize the problems of using holes for this function and thus, Fusejima I does not provide any motivation for one of ordinary skill in the art to modify the partition plates 52 to form apertures in addition to or instead of vent holes.

With respect to partition walls, the Office Action asserts that partition walls described in Fusejima I provide a guide permitting flow of the drying gas from inside to outside of the rotary drum together with "the annual duct, the gas supply duct, and/or separation members." However, this contention derives from improper reading of claim 1. That is, in the claimed device, apertures are present in a drum, and thus form a part of a drum. However, partition walls in the coating device of Fusejima I are not present in a drum. As described in Fusejima I, the annular duct 24 is defined by: a cylindrical inner wall portion 25 which surrounds the cylindrical portion 2 through a slit; an outer wall portion 26 which is located to the inner wall portion 25 through a space; and side wall portions 27 and 28. In the annular duct 24, there is formed a vent path 24a located at the outside of the cylindrical portion 2 in a manner to surround the cylindrical portion 2." That is, the partition walls are present in the annual duct, not in the drum. Therefore, even considering partition walls, Fusejima I still fails to teach or suggest all limitations of claim 1 because the drum of the coating device of Fusejima I does not comprise partition walls that form apertures between them.

As indicated above, because Fusejima I does not recognize the advantages of using apertures defined by mutually parallel sections over holes in a drum, it does not provide any motivation or suggestion that one of ordinary skill in the art would have modified partition walls in the drum to provide apertures instead of or in addition to vent holes.

By the same token, no amount of experimentation by one of ordinary skill in the art reading Fusejima I could render the present claims obvious. The addition of Fusejima II does not cure this defect. Therefore, neither Fusejima I nor Fusejima II, alone or in combination, evidences motivation for one of ordinary skill in the art to modify either partition plates or partition walls to produce the claimed device. Consequently, the Office Action has failed to establish a *prima facie* case of obviousness. Accordingly, applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

In view of the above amendments and remarks, favorable reconsideration and allowance of the application are respectfully requested. In the event that any issues remain, the Examiner is invited to telephone the undersigned with any proposal to expedite prosecution.

Respectfully submitted,

Date April 1, 2003

By Stephen B. Maebius

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Stephen B. Maebius
Attorney for Applicants
Registration No. 35,264

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Four Times Amended) A device for producing granules comprising a drum with peripheral apertures, a member for feeding said drum with coating or fixing substance, and a member for supplying gas, wherein said [drum comprises] peripheral apertures are defined by the space between mutually parallel sections contained in said drum [that define, between them] and, wherein a gas passes through said peripheral apertures [that form a path for a gas flow] between the inside and the outside of said drum.